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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,615	12/01/2000	Marie Angelopoulos	YOR919960050US3	4765

7590 05/31/2007
Dr. Daniel P. Morris, Esq.
IBM Corporation
Intellectual Property Law Dept.
P.O. Box 218
Yorktown Heights, NY 10598

EXAMINER

KOPEC, MARK T

ART UNIT	PAPER NUMBER
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1751

MAIL DATE	DELIVERY MODE
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05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/727,615

Applicant(s)

ANGELOPOULOS ET AL.

Examiner

Mark Kopec

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/07/06 has been entered.

Claims 1-24 are currently pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The new language "...wherein said additive has a different material composition from said additive" is indefinite. How can an additive differ in composition (from itself)? Clarification is required.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as anticipated by Angelopoulos et al (5,804,100).

These rejections are maintained for the reasons set forth at pages 10-16 of Paper #5 (Rejection mailed 2/28/03).

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The Amendment to correct Inventorship under 37 C.F.R. §1.48(a) is noted. The examiner finds the following deficiencies:

The Declaration filed 4/6/04 (Bruce Kenneth Furman) does not contain all named inventors. See 37 C.F.R. §1.48 (a)(3) and 37 C.F.R. §1.63.

Applicant's remarks filed 12/07/06 are noted. Specifically, applicant states "Applicant's have amended the inventorship of the present application so that the present application is identical to that of US Patent 5,804,100. Thus, US Patent 5,804,100 cannot be a 35 USC 102(e) reference". Applicant also indicates that each inventor can sign a separate declaration paper and therefore the declaration signed by inventor Furman is sufficient.

The examiner does not dispute that each inventor can sign a separate declaration paper. However, as stated in 37 C.F.R. §1.63, each signed oath/declaration must:

(1) Be executed, i.e., signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;

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(2) **Identify each inventor by full name**, including the family name, and at least one given name without abbreviation together with any other given name or initial;

(3) **Identify the country of citizenship of each inventor;**
and

(4) State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

The newly supplied declaration (of Bruce Furman) does not include the information required per 37 C.F.R. §1.63 (i.e. the declaration does not contain the names/residence/citizenship of the co inventors). Furthermore, newly signed oath/declarations executed by the "original inventors" must be supplied. See 37 C.F.R. §1.48(a) and 37 C.F.R. §1.63.

Additionally, applicant's statement "Applicant's have amended the inventorship of the present application so that the present application is identical to that of US Patent 5,804,100. Thus, US Patent 5,804,100 cannot be a 35 USC 102(e) reference" appears in error. Specifically, U.S 5,804,100 contains two inventors: Marie Angelopoulos and Bruce Furman. The instant application additionally contains Yun-Hsin Liao and Ravi F. Saraf as inventors. Even if applicant were to supply a new

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declaration meeting the above listed requirements of 37 C.F.R.

\$1.48, the instant inventive entity is different from that of US 5,804,100 and such would still be available under 35 USC 102(e).

In view of the foregoing, the above claims have failed to patentably distinguish over the applied art.

Applicant is reminded that any evidence to be presented in accordance with 37 C.F.R. 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Kopec/
Primary Examiner
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MK
May 28, 2007